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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,983	06/14/2001	Isaac K. Elliott	VON96046C1	6036

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EXAMINER

PHAN, MAN U

ART UNIT	PAPER NUMBER
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2619

NOTIFICATION DATE	DELIVERY MODE
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04/03/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/879,983	Applicant(s) ELLIOTT ET AL.	
	Examiner Man Phan	Art Unit 2619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the appeal brief filed on 12/12/2007, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols @, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

Claim Objections

3. Claim 3 is objected to because of the following informalities:

On line 3, the "medial communication" should be changed to "media communication".

Appropriate correction is required.

Claim Rejections - 35 USC ' 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, 4, 5 recite limitations "a third entry indicative" and "additional entry" and "parsing a field" in lines 2 respectively. The claimed method fails to indicate any interaction between elements (modes, links, process) as to how the "entry indicative", "parsing field" are determined. The term "*a third entry indicative*" or "*parsing a field*" is not defined by the claims, does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear what constitutes such "*a third entry indicative*" or "*parsing a field*". It is not clear what kind of entry for this third entry (billing entry, network entry, data entry, user entry...), what involved in "*parsing a field*", and are there the first or second entry associated with the third entry or additional entry.

Claim Rejections - 35 USC ' 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 1038 and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 5-8 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldred et al. (US#5,719,942) in view of Turock (US#6,243,373).

Regarding claims 10-11, the references disclose a novel system and method for responding to requests for quality of services and reserving the resources to provide the requested services, according to the essential features of the claims. Aldred et al. (US#5,719,942) provides a communications system for transmitting and/or receiving data over a network, said communications system including means responsive to requests for a desired quality of service specifying at least two quality of service parameters, for determining whether or not the requested quality of service is available, characterized in that said determining means is responsive to quality of service requests specifying the desired quality of service as a logical expression involving two or more of said at least two quality of service parameters (*logic for responding to requests for QoS and reserving the resources to provide the requested services*). Typically the quality of service requests are received from applications intending to initiate data

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communications over said network. The determining means then compares the requested quality of service parameters with the facilities provided by the communications link(s) available to the communications system. If a match is obtained, then the requested transmission can be accepted, otherwise it must be refused (See Flow chart 9h; Col. 1, lines 52 plus). Aldred further teaches in Fig. 9c depicts the scenario when a resource manager needs to negotiate with applications to determine what resources are available, in which the call manager determines whether or not application 2 can supply the resource. The determination is effected using a request.sub.--resource function call, raising a RESOURCE.sub.--REQUEST event in application 2 (*request resources*). On return, application 2 indicates whether or not the resources are available (*allocating necessary resources*). Application 2 should now be prepared to release the resources (*releasing necessary resources*). When the call manager completes the processing of the outstanding RESOURCE.sub.--CLAIM event from application 1, the resources are further transferred from the call manager to application 1 (*message sequence for releasing the resources allocated to a call on termination of the call*)(Col. 15, lines 65 plus).

Aldred et al. (US#5,719,942) does not disclose expressly the media communication over a hybrid network which includes a circuit switched network and a packet switched network. However, Aldred teaches a system and method for establishing a communication channel over a heterogeneous network between a source node and a destination node, in which a heterogeneous network that links between nodes have different characteristics (*hybrid network communications*). In the same field of endeavor, Turock (US#6,243,373) discloses (Fig 2-10 and col. 5, lines 17 to col. 15, lines 54) a plurality of gateways (Fig 2, Ref 206 and 216) and call router (Fig 5, Ref 512) which connects the switched communication network and the packet network having

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a logic (Fig 5, Ref 506) which transmits a query message which includes a call type of service to the directory service (Fig 5, Ref 514) to obtain a plurality of gateways that match the predefined call service criteria including QOS "cost" and a gateway registration scheme "gateways registered in the database" (See col. 9, lines 1-25) and an identifier of the call to an associated IP address; ranging the selected gateways according the least cost routing; selecting a shortest path gateway for placing a telephone call and selecting a next one if the shortest one is not available (See col. 9, lines 26- 65).

Regarding claim 6, Aldred teaches the Quality of service information characterizes the communication capabilities of the link. For each link type the link selection order, and defaults for the quality of service characteristics, are stored in the configuration profile (*profile information associated with a caller for communications*). The quality of service profile contains the necessary information for the support system to decide whether and how compression and encryption should be used. The value in the profile entry is used to fill in the fields of a launch call, which is then executed (*profile information of the caller is used in establishing media communications*).

Regarding claims 1 and 7-8, they are method claims corresponding to the system claims 10-11 above. Therefore, claims 1, 7-8 are analyzed and rejected as previously discussed with respect to claims 10-11.

One skilled in the art would have recognized the need for effectively and efficiently providing requested quality of service routing in networks, and would have applied Turock's novel use of internet telephone system utilizing the quality of the voice into Aldred' logic for responding to request for quality of service parameters in network communications. Therefore,

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Turock's method and apparatus for implementing a computer network/ internet telephone system into Aldred et al.'s system and method for establishing a communication channel over a heterogeneous network a source node and s destination node with the motivation being to provide a system and method for providing requested quality of service in a hybrid network.

9. Claims 2-5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldred et al. (US#5,719,942) in view of Turock (US#6,243,373) as applied to the claims above, and further in view of Ronen et al. (US#5,905,736).

With respect to claims 2, 9, Aldred et al. (US#5,719,942) and Turock (US#6,243,373) disclose the claimed limitations discussed in paragraph 5 above. However, these claims differ from the claims above in that the claims require the bill detail record including an entry indicative of the requested QoS. In the same field of endeavor, Ronen et al. (US#5,905,736) disclose in fig. 1 a block diagram illustrated the network elements for providing the centralized billing functionality for transactions conducted by a user through an Internet Access Provider, in which upon connection of the user's terminal (101) to the IAP, the IAP transmits to a billing platform (108) a message that associates the user's identity and the temporary Internet Protocol (IP) address that is assigned by the IAP to the user's session for use by to that user's terminal. In response to a chargeable transaction with an ISP, the ISP transmits to the billing platform the IP address of the user making the transaction and the charge for the transaction. The charges for all such transactions are accumulated by a transaction server (109) and stored in an account on an

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associated database (110) identified with the IP address of the requesting terminal (*bill detail record with requested QoS*). At the end of the user's session, the charges for all the transactions during the session that are stored on the transaction server database in the account identified with the IP address, are charged to an account associated with the user's identity that is stored on a database (112) of a billing server (111) by cross-referencing the IP address to the user's identity from the previously received and stored message (See also Fig. 3; Col. 4, lines 3 plus and Col. 7, lines 52 plus).

In so far, as understood with respect to claims 3-5, Aldred further teaches in table 1 illustrated a record of the availability of communication resources that kept and managed by the support system at each node. Upon receiving a request for particular resources, the above record is consulted and a determination is made therefrom as to whether the request can be supported. If the request can be supported, the record is updated to reflect the fact that particular resources have been allocated and are no longer available for the duration of an such allocation. Such a record can be realised using any appropriate data structure (*table data entry indicative of the media communications*). Details identifying the true nature of the communicating device are made available in the user information field.

One skilled in the art would have recognized the need for effectively and efficiently providing requested quality of service routing in networks, and would have applied Ronen's teaching of the billing detail record and Turock's novel use of internet telephone system utilizing the quality of the voice into Aldred' logic for responding to request for quality of service parameters in network communications. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Ronen's method for the

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billing of transaction over the internet, and Turock's method and apparatus for implementing a computer network/ internet telephone system into Aldred et al.'s system and method for establishing a communication channel over a heterogeneous network a source node and a destination node with the motivation being to provide a system and method for providing requested quality of service in a hybrid network.

Double Patenting

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain : patent therefor ..." (Emphasis added). Thus, the term "same invention" in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-11 of the present application Serial No. 09/879,983 (hereinafter Application '983) rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,335,927 (hereinafter patent '927) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The claims are identical and they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, since the patent and the application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are equivalent in scope and embodiment. The language of the two claims is substantially identical and is equivalent in functioning. All of the structural elements of the patent claims are present in the pending claims, defined with either identical or equivalent

language. Additionally, the functional language, scope and embodiment reflects identical operation, purpose, application, and environment.

With respect to the specific limitations, The combination of the pending claims 1, 2-4 and 7-9 of Application '983 are equivalent to the claim 1-4 of patent '927.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Crawley et al. (US#5,995,503) is cited to show the method and apparatus for providing QoS routing in a network.

The Doshi et al. (US#5,291,481) is cited to show the congestion control for high speed packet networks.

The Hogan et al. (US#6,016,343) is cited to show the call processing system and method.

The Gusella et al. (US#5,408,465) is cited to show the flexible scheme for admission control of multimedia stream on integrated networks.

The Esaki et al. (US#5,153,877) is cited to show the packet network with communication

resource allocation and call set up control of higher QoS.

The Kujoory et al. (US#6,021,263) is cited to show the management of ATM virtual circuits with resources reservation protocol.

The Drake, Jr. et al. (US#5,461,611) is cited to show the QoS management for source routing multimedia packet networks.

The Gawlick et al. (US#6,175,870) is cited to show the method of admission control and routing of virtual circuits.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149. The examiner can normally be reached on Mon - Fri from 6:00 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel, can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to

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the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

03/28/2008

/Man Phan/

Primary Examiner, Art Unit 2619